

Patent  
KG-1807

In the application of: Joe L. Hurst et al.  
Serial No.09/928,376 Filed: August 13, 2001  
Response to Final Office Action of January 12, 2004

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Remarks

Introduction

This paper is in response to the Final Office Action mailed January 12, 2004. Claims 22 – 27, 31 and 32 remain in the case and stand under final rejection based upon prior art. This Response presents two basic arguments. The first is that applicant respectfully submits that the Office Action should not have been made final by the examiner. The second is that there is no motivation to combine the two documents that form the basis for the obviousness rejection, and that even if such a combination is proper, it does not meet the invention per the pending claims.

Applicant's detailed reasons and support of its opposition are set forth below.

The Finality of the Office Action is Premature

MPEP 706.07 requires that before a final rejection is in order that, "... a clear issue should be developed between the examiner and applicant." See Page 700-71. MPEP 706.07 further says that while the rules no longer give to an applicant the right to, "... amend as often as the examiner presents new references or reasons for rejection, ...", present practice does not sanction hasty and ill-considered rejections. *Id.* Further, MPEP 706.07 says that the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. See Page 700-72.

In the first Office Action mailed on April 17, 2003, the examiner utilized Werner, Schretter and Andersson to formulate the rejections against claims 22-27, 31 and 32. In response to such rejection, applicant amended the claims so that the "acute locating angle" was changed to read "included locating angle". Further, applicant successfully overcame the examiner's rejections based upon the combination of Werner and Schretter as indicated by the examiner's comment on page 3 of the pending Office Action.

In view of the nature of applicant's amendment of the claims and the fact that the examiner agreed with applicant's arguments regarding Werner and Schretter, applicant submits that it does not seem fair for the examiner to make this Office Action final. Prior

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to this action, applicant has not had a chance to address the merits of the rejection based upon Posch (European Patent No. 0 504 995) taken in view of Cook (U.S. Patent No. 5,067,858). Therefore, applicant submits that the finality of this rejection is premature since applicant has not had a full and fair hearing on the issue. Applicant respectfully requests that the examiner withdraw the finality of this Office Action.

The Applied References Do Not Address the Claimed Invention

Claim 22 is the only independent claim in the pending patent application. Claim 22 requires, in part, that the cutter body include a "pentagonal pocket having an included locating angle for positioning and retaining said cutter insert in position." In regard to the substantive merit of the rejection, it is clear that Posch does not address the recitation of a pentagonal pocket. In fact, the examiner admits on page 2 of the pending Office Action that Posch does not disclose a pentagonal pocket. In an attempt to address this deficiency in Posch, the examiner cites Cook and argues that the pocket 66 of Cook is a pentagonal pocket. Applicant respectfully submits that Cook does not teach or suggest a pentagonal pocket, but merely shows a pentagonal cutting insert. In this regard, it appears that the pocket 66 of Cook presents three sides that are unlike the five-sided pentagonal pocket of the present invention. In this regard, applicant refers the patent examiner to FIG. 9 of the present patent application and the description that the pentagonal pocket that has a general pentagonal house shape.

The other claims depend in some form from claim 22, and applicant respectfully submits that these claims are allowable for all of the reasons advanced in support of claim 22. Further, applicant points out that claims 31 and 32 require that the included locating angle is between 90 and 150 degrees. To the extent that Cook can be said to have a locating angle, it appears that this angle is less than 90 degrees so that in no way does the combination of Posch and Cook address the invention as claimed in claims 31 and 32.

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Conclusion

For the above reasons, applicant respectfully submits that the present Final Office Action is premature because the applicant has not been entitled to a full and fair hearing on the pending rejection based upon the combination of Posch and Cook. Further, applicant respectfully submits that the combination of Posch taken in view of Cook does not teach or suggest the present invention as claimed in claim 22.

In view of the above comments, applicant respectfully requests a Notice of Allowance indicating the claims as being allowable. If for any reason the examiner does not believe that the application is in condition for allowance, and especially has any suggestions to place the case in form for allowance, the examiner is urged to telephone the undersigned attorney (615-662-0100) or Mr. John J. Prizzi (724-539-5331) to discuss the situation in order to expedite the prosecution of the patent application.

Respectfully submitted,

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